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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,980	03/23/2004	Ryan McFarland	RM/04	4500
7590	07/19/2006		EXAMINER	
Gene R. Woodle 3516 Woodle Drive Rapid City, SD 57702			VANAMAN, FRANK BENNETT	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,980	MCFARLAND, RYAN	
	Examiner Frank Vanaman	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 May 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 23 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

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Status of Application

1. Applicant's amendment, filed May 13, 2006, has been entered in the application. Claims 1-12 remain pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the engagement of the bar in a position where the top is rearward of the bottom (claim 3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 3, as clarified, refers to the engagement of the bar and cart in any position where the top of the bar is rearward of

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the bottom of the bar. The specification as filed fails to disclose such an arrangement. See page 3, lines 23-25; page 6, lines 11-14, where the engagement is discussed but the particular orientation is not described. The examiner notes that the drawings fail to show such a condition. While the specification fails to specifically teach the engagement set forth in claim 2, the originally filed drawings do appear to support that particular arrangement.

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 1, it is not clear what aspects of a cart associated with the term "conventional" are or are not being recited.

5. As regards claims currently rejected under 35 USC §112, second paragraph, please note that rejections under 35 USC §102 and 103 should not be based upon considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims when the claims are not definite. See *In re Steele* 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become anticipated or obvious, but rather the claim becomes indefinite. See *In re Wilson* 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As such the currently pending claims may be subject to prior art rejections not set forth herein upon the clarification of the claim language.

Claim Rejections - 35 USC § 103

6. The portions of 35 USC relied upon herein may be found cited in a previous office action.

7. Claims 1, 2, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner (US 6,641,147) in view of Baumgart (US 2,845,729). Werner teaches an extender for use with a conventional shopping cart including a bar (100) in the shape of an open rectangle, affixed to the front of the cart (at 96) at a top thereof, the bar being perpendicular to a longitudinal cart axis, the bar including an upwardly protruding stop portion (102, 98) positioned thereabove at the top-most extremity of the mechanism,

and arranged to be movable to a position where the bar forms a level surface to prevent the load from shifting forward or backwards, wherein the bar may be engaged from a position forwardly thereof. The reference to Werner fails to teach the bar portion as being pivotable between load-accommodating and nested-cart positions, and further having an engaging portion to facilitate the load-accommodating position. Baumgart teaches the use of a pivotable connection to pivot an element (17) to be above a cart front (figure 1), and to collapse to a nesting-cart configuration (figure 3) including an engagement portion (bottom of 17, top of 14) which hold the pivotable element in an extended position (figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the load accommodating bar taught by Werner as a pivotally mounted element, as taught by Baumgart, rather than a slidably mounted element, for the purpose of allowing the load accommodating bar to be automatically stowed when the cart is nested with another, thus reducing time and effort required to store the carts compactly.

8. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner in view of Baumgart and Duer (US 5,429,377). The references to Werner and Baumgart are discussed in detail above and fail to teach the provision of upwardly protruding ears at the ends of the handle. Duer teaches a handle arrangement (figures 49, 50, 51) wherein a handle (145, 149) is provided with upwardly extending ears (151) at each end thereof. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the handle of the cart taught by Werner as modified by Baumgart with a handle as taught by Duer, having upwardly extending ears at ends thereof, for the purpose of providing a presenting a clean surface and preventing damage to the structure beneath it.

Claims Not Rejected over the Prior Art

Claim 3, as best understood, is not rejected as being anticipated by or obvious over the prior art of record, but is not in condition for allowance at this time in view of the rejection set forth under 35 USC 112, first paragraph.

Response to Comments

Applicant's comments, filed with the amendment, have been carefully considered. As regards applicant's inquiry as to the use of "conventional" in claim 1, the examiner expresses some substantial surprise that applicant requests amplification on this matter. "Conventional" is being used to modify "shopping cart", however no specific limitations associated with the term conventional have been set forth. This makes the scope of the claim unclear, and it is not possible to discern what limitations associated with the term conventional are or are not to be applied with the use of the term. Applicant is undoubtedly aware that the prior art is chock-full of shopping carts, many of which have been marketed and seen use in the commercial world. They are all different in some way. The use of the term renders the recitation of the cart unclear because it does not refer to what particular way the cart is 'conventional'. Is it conventional because it has 4 wheels (and as such, then does the recitation of the cart include wheels which are unrecited)? Is it conventional in that it has a plastic basket? Is it conventional in that it has an auto theft feature built in to a wheel? Is it conventional in that it includes a child's seat? Does 'conventional' include all the characteristics of **all** carts in commercial use?

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 4 of the comments), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant has asserted that the reference to Werner includes more elements (and may be more complicated) than applicant's inventive device. This may be so, but the presence of additional material taught by the prior art does not render it inapplicable against a claim reciting elements which it teaches. In response to applicant's argument that Baumgart and Duer are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

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reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Baumgart is directed to the connection of a device which may be automatically retracted when a shopping cart is nested with other carts, which feature is indeed one with which applicant's invention is also addressed see page 7, lines 2-8 of applicant's own specification. As regards the reference to Duer, again, the examiner notes that both Duer and the instant applicant are directed to providing a specific structural arrangement or characteristic to a handle portion of a shopping cart, and while the structures may be used for different purposes, the fact that applicant has recognized a different advantage which would flow from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant has asserted that "the sign in Baumgart does not connect or interlock with anything". This is simply untrue, and can be construed as misleading. Element 32 engages the top of element 14 in the extended condition. This is very clearly shown in the figures (at least figures 1, 2, and 3) and is additionally specifically set forth in the specification at col. 3, lines 13-18. For the purpose of clear prosecution applicant is hereby explicitly invited to provide evidence to support the statement that Baumgart's sign 'does not connect or interlock with anything', and a fully responsive amendment or request for reconsideration would be expected to include such evidence.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant has asserted that "any rejection of claims is improper under section 103, if no teaching, suggestion, or incentive supporting the combination is found in the prior art". This is not at all correct and may be deemed misleading at best, and again the examiner expresses some surprise that applicant is unfamiliar with practice under 35 USC 103. It has been long and well held that a conclusion of obviousness may be made

from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish* 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500 (Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997). Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

More recently, In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem." Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the

combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

Applicant's comments directed to the reference of Werner "if it wasn't obvious to him, it shouldn't be considered obvious" is noted, though this appears to be directed to the notion that the prior art must explicitly teach a motivation for combination (or, perhaps, that it may only be applied if it anticipates a claim), however if Werner were to teach all particular limitations of a claim, there would be no obviousness-type rejection, rather there would be an anticipation rejection. As such, the argument does not appear to be directed to the concept of the term obviousness as applied in the context of that term's use with respect to patent prosecution.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

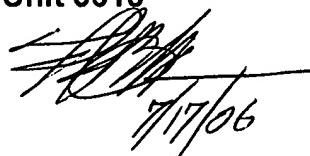
A response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

F. VANAMAN
Primary Examiner
Art Unit 3618


7/17/06